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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,783	01/23/2004	Scott F. Watson	54317-048500	9741
46560 7590 12/21/2007 THE WALT DISNEY COMPANY C/O GREENBERG TRAURIG LLP 2450 COLORADO AVENUE SUITE 400E SANTA MONICA, CA 90404			EXAMINER WANG, LIANG CHE A	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/764,783

Applicant(s)

WATSON, SCOTT F.

Examiner

Liang-che Alex Wang

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 31-60 are presented for examination.
2. This action is in response to amendment filed on 11/29/2007.

### *Response to Arguments*

3. Applicant's arguments filed 11/29/2007, have been fully considered but they are not persuasive.
4. In that remarks, applicant's argues in substance:
  - a. That: The applicant believes that the Examiner may have made a mistake because claim 51 is mentioned a "computer program carrier," it does NOT refer to electromagnetic radiation and requires a computer, which is clearly statutory.

In response to applicant's argument, the support of the limitation "computer program carrier" could found in page 13 lines 16-22, where the term of "article of manufacture" as used herein intended to encompass a computer program accessible from any computer readable device, **carrier** or media.", and by the definition of "carrier" in computer communication environment, "carrier" is a radio wave that can be modulated in order to transmit a signal which is non-statutory and does not fall into the categories of "process", "machine", "manufacture" and "composition of matter". Therefore claim 51 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Rejection is maintained.

- b. That: Dwek shows a network where a server is connected to multiple other client computers, NOT the user of a client computer as described in the Applicant's independent claim 31.

In response to applicant's argument, Dwek in Col 3 lines 44-49 shows a multimedia content delivery system includes a novel media player which is downloaded onto a user's personal computer. The media player comprises a user interface which allows a user to search an online database of media selections and build a custom playlist. It is clear that the media player on each personal computer is used by a user. So when the content is downloaded from the server to the client computer, it is providing data to the user of the client computer.

Rejection is maintained

#### ***Claim Objections***

5. Claims 42-50 are objected to because of the following informalities:
6. Referring to claims 42-50, claims 42-50 recites the limitation "The method of ...", however claims 42-50 are dependent claims depends on independent claim 41, and claims 41 recites an apparatus. Therefore the claims should be changed to "The apparatus of ...".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 51-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP § 2106.01. Claims 51-60 recites “an article of manufacture comprising a computer program carrier readable by a computer”, however, a computer program having code recorded on a computer readable medium such as carrier wave or optical wave is not tangible since such computer transport medium does not fall into the categories of “process”, “machine”, “manufacture” and “composition of matter”. Furthermore, the computer program stored on carrier wave is not operable if not executed by a computer or system. Therefore, the inoperative of the computer program stored on a computer transport medium lacks utility. Intrinsic evidence as disclosed in page 13 lines 16-22 of the specification.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 31-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Dwek, US Patent Number 6,248,946, hereinafter Dwek.

11. Referring to claim 31, Dwek teaches a method (Col 4 lines 18-21) of providing data to a user of a client computer (user of client 130, Figure 1, Col 3 lines 44-49) connected to multiple data stores (Song File Server 116) and multiple other computers (Streaming Server 118 and other client 130s), the method comprising the steps of: providing a user interface (user interface 250, figure 2) to enable the user to identify desired data (Col 4 lines 35-38, user selection); retrieving the desired data (Col 4 lines 63-65, locating music file); and providing the desired data to the user (Col 4 lines 65-67, returning back to user).
12. Referring to claim 32, Dwek teaches the method of claim 31, wherein the user interface provides categories of data (figure 3A).
13. Referring to claim 33, Dwek teaches the method of claim 32, wherein the categories of data include music categories (figure 3A).
14. Referring to claim 34, Dwek teaches the method of claim 32, wherein the categories of data include news categories (Col 12 lines 15-22, new recording release corresponds to news categories).
15. Referring to claim 35, Dwek teaches the method of claim 31, wherein the desired data comprises one or more music files that are played with a media player (Col 8 lines 19-26, songs are played by user's music player).
16. Referring to claim 36, Dwek teaches the method of claim 35, further comprising providing a music controller (Col 2 lines 16-26, figure 3A).
17. Referring to claim 37, Dwek teaches the method of claim 35, wherein the user interface enables a user to create music filters (Col 2 lines 16-23).

18. Referring to claim 38, Dwek teaches the method of claim 37, wherein a music filter comprises data on how frequently a music file is to be played (Col 2 lines 16-23, play frequency).
19. Referring to claim 39, Dwek teaches the method of claim 35, wherein the user interface enables a user to create a custom station (Col 9 lines 18-30, figure 3B).
20. Referring to claim 40, Dwek teaches the method of claim 39, wherein the user interface enables a user to share the custom station with another user (Col 9 lines 32-45).
21. Referring to claim 41, Dwek teaches an apparatus (Col 4 lines 18-21) for providing data to a user of a client computer (client 130, Figure 1), comprising:
  - a. a client computer (client 130) connected to multiple data stores (Song File Server 116) and multiple other computers (Streaming Server 118 and other client 130s);
  - b. one or more computer programs, performed by the client computer and multiple other computers for, providing a user interface (user interface 250, figure 2) to enable the user to identify desired data (Col 4 lines 35-38, user selection); retrieving the desired data (Col 4 lines 63-65, locating music file); and providing the desired data to the user (Col 4 lines 65-67, returning back to user).
22. Referring to claim 42, Dwek teaches the apparatus of claim 41, wherein the user interface provides categories of data (figure 3A).
23. Referring to claim 43, Dwek teaches the apparatus of claim 42, wherein the categories of data include music categories (figure 3A).

24. Referring to claim 44, Dwek teaches apparatus of claim 42, wherein the categories of data include news categories (Col 12 lines 15-22, new recording release corresponds to news categories).
25. Referring to claim 45, Dwek teaches the apparatus of claim 41, wherein the desired data comprises one or more music files that are played with a media player (Col 8 lines 19-26, songs are played by user's music player).
26. Referring to claim 46, Dwek teaches the apparatus of claim 45, further comprising providing a music controller (Col 2 lines 16-26, figure 3A).
27. Referring to claim 47, Dwek teaches apparatus of claim 46, wherein the user interface enables a user to create music filters (Col 2 lines 16-23).
28. Referring to claim 48, Dwek teaches the apparatus of claim 47, wherein a music filter comprises data on how frequently a music file is to be played (Col 2 lines 16-23, play frequency).
29. Referring to claim 49, Dwek teaches the apparatus of claim 45, wherein the user interface enables a user to create a custom station (Col 9 lines 18-30, figure 3B).
30. Referring to claim 50, Dwek teaches the apparatus of claim 49, wherein the user interface enables a user to share the custom station with another user (Col 9 lines 32-45).
31. Referring to claim 51, Dwek teaches an article of manufacture comprising a computer program carrier readable by a computer and embodying one or more instructions executable by the computer to perform method steps (Col 4 lines 18-21) for providing data to a user of a client computer (client 130, Figure 1) connected to multiple data stores (Song File Server 116) and multiple other computers (Streaming Server 118 and other



client 130s), the method comprising the steps of: providing a user interface (user interface 250, figure 2) to enable the user to identify desired data (Col 4 lines 35-38, user selection); retrieving the desired data (Col 4 lines 63-65, locating music file); and providing the desired data to the user (Col 4 lines 65-67, returning back to user).

32. Referring to claim 52, Dwek teaches the article of manufacture of claim 51, wherein the user interface provides categories of data (figure 3A).

33. Referring to claim 53, Dwek teaches the article of manufacture of claim 52, wherein the categories of data include music categories (figure 3A).

34. Referring to claim 54, Dwek teaches the article of manufacture of claim 52, wherein the categories of data include news categories (Col 12 lines 15-22, new recording release corresponds to news categories).

35. Referring to claim 55, Dwek teaches the article of manufacture of claim 51, wherein the desired data comprises one or more music files that are played with a media player (Col 8 lines 19-26, songs are played by user's music player).

36. Referring to claim 56, Dwek teaches the article of manufacture of claim 55, further comprising providing a music controller (Col 2 lines 16-26, figure 3A).

37. Referring to claim 57, Dwek teaches the article of manufacture of claim 55, wherein the user interface enables a user to create music filters (Col 2 lines 16-23).

38. Referring to claim 58, Dwek teaches the article of manufacture of claim 57, wherein a music filter comprises data on how frequently a music file is to be played (Col 2 lines 16-23, play frequency).

39. Referring to claim 59, Dwek teaches the article of manufacture of claim 55, wherein the user interface enables a user to create a custom station (Col 9 lines 18-30, figure 3B).
40. Referring to claim 60, Dwek teaches the article of manufacture of claim 59, wherein the user interface enables a user to share the custom station with another user (Col 9 lines 32-45).

### *Conclusion*

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

42. Deguchi. US Patent Number 7,127,454, teaches a user terminal connected to a server terminal for transmitting find music search request.
43. Ramaswamy, US Patent Number 7,284,036, teaches a music server notifying the user that an MP3 file has been retrieved and is ready for downloading.

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (571)272-3992. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang  
December 11, 2007

A handwritten signature in black ink, appearing to read "Liang-che Wang", written in a cursive style.